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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,078	03/13/2001	Renpei Nagashima	084335-0119	9105

22428 7590 07/28/2003

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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DOUGHERTY, ANTHONY T

ART UNIT	PAPER NUMBER
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2863

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/804,078

Applicant(s)

NAGASHIMA, RENPEI

Examiner

Anthony T. Dougherty

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8,11 and 12 is/are rejected.
- 7) ☐ Claim(s) 3,4,9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claims 3, 4, 9, and 10 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With regard to claim 3, the limitation “to relate a set of structural data and functional data of a chemical substance” is recited, claim 3 is dependent on claim 1 which recites the limitation “a set of structural data and functional data of a chemical substance, ..., is related” – changing the order of this grouping of words in this case does not change the meaning and thus claim 3 fails to further parent limit claim 1 since claim 3 is a repetition of a part of claim 1.

With regard to claim 4, the limitation “analyze and classify, and further convert a set of structural data and functional data of a chemical substance in a form which enables individual or company or organization or group who has submitted the original set of structural data and functional data to conveniently search for needed information at later times, and accommodate and cumulatively store such converted data in a data base” is recited, claim 4 is dependent on claim 1 which recites the limitation “a set of structural data and functional data of a chemical substance, ... is analyzed and classified, and further converted in a form which enables corresponding individual or company or organization or group who has submitted the original set of structural data and functional data to conveniently search for needed information at later times, and accommodated and cumulatively stored in another data base” – again changing the

Art Unit: 2863

order of the wording does not change the meaning and thus claim 4 fails to further limit parent claim 1 since claim 4 is a repetition of a part of claim 1.

With regard to claim 9, the limitation “to relate a set of structural data and functional data of a chemical substance” is recited, claim 9 is dependent on claim 7 which recites the limitation “a set of structural data and functional data of each of chemical substances ... is related” – changing the order of this grouping of words, in this case, does not change the meaning and thus claim 9 fails to further parent limit claim 7 since claim 9 is a repetition of a part of claim 7.

With regard to claim 10, the limitation “analyze and classify, and further convert a set of structural data and functional data of a chemical substance in a form which enables a person to conveniently search for needed information at later times, and accommodate and cumulatively store such converted data in a data base” is recited, claim 10 is dependent on claim 7 which recites the limitation “a set of structural data and functional data of each of chemical substances, ... is analyzed and classified, and further converted in a form which enables a person to conveniently search for needed information at later times, and accommodated and cumulatively stored in another data base” – again changing the order of the wording does not change the meaning and thus claim 10 fails to further limit parent claim 7 since claim 10 is a repetition of a part of claim 7.

2. Claim 11 objected to because of the following informalities: Claim 11 recites the limitation “information library or chemical substances”, it is believed by the examiner that this is

Art Unit: 2863

a typographical error and for examination purposes has been treated as if it read "information library of chemical substances" instead. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5-8, 11, and 12 rejected under 35 U.S.C. 102(b) as being anticipated by International Application Number PCT/US97/01491 to Patterson et al.

With regard to claim 1, Patterson et al. discloses a method in which a set of structural data and functional data of a chemical substance, which is internal information of a single individual or a single company or a single organization of a single group, is related and accommodated in a data base (see page 53 line 5 through line 8), such related set is analyzed (see page 79 line 13 through line 26) and classified, and further converted in a form (see page 79 line 27 through page 80 line 20) which enables corresponding individual or company or organization or group who has submitted the original set of structural data and functional data to conveniently search for needed information at later times (see page 88 line 18 through line 33), and accommodated and cumulatively stored in another data base (see page 89 line 1 through line 3).

Art Unit: 2863

With regard to claim 2, and applying the rejection of claim 1 above, Patterson et al. discloses a data base (see page 89 line 1 through line 3).

With regard to claim 5, and applying the rejection of claim 1 above, Patterson et al. discloses an information library of chemical substances (see page 78 line 5 through line 13).

With regard to claim 6, and applying the rejection of claim 5 above, Patterson et al. discloses means to enable individual or company or organization or group who has submitted the original set of structural data and functional data to search for needed information at different times (see page 91 line 12 through line 32).

With regard to claim 7, Patterson et al. discloses a method in which a set of structural data and functional data of each of chemical substances possessed internally by multiple sectors selected from individuals, companies, organizations, and groups of individuals is related and accommodated in a data base (see page 53 line 5 through line 8), such related set of data is analyzed (see page 79 line 13 through line 26) and classified, and further converted in a form (see page 79 line 27 through page 80 line 20) which enables a person to conveniently search for needed information at later times (see page 88 line 18 through line 33), and accommodated and cumulatively stored in another data base (see page 89 line 1 through line 3).

With regard to claim 8, and applying the rejection of claim 7 above, Patterson et al. discloses a data base (see page 89 line 1 through line 3).

Art Unit: 2863

With regard to claim 11, and applying the rejection of claim 7 above, Patterson et al. discloses an information library of chemical substances (see page 78 line 5 through line 13).

With regard to claim 12, and applying the rejection of claim 11 above, Patterson et al. discloses means to enable a person to search for needed information at different times (see page 91 line 12 through line 32).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,240,374 to Cramer et al. because it teaches the same material as International Application Number PCT/US97/01491 to Patterson et al.

U.S. Patent No. 6,185,506 to Cramer et al. because it teaches screening and building a library of chemical substances.

U.S. Patent No. 4,811,217 to Tokizane et al. because it teaches a method of storing and searching chemical structure data.

U.S. Patent No. 5,025,388 to Cramer, III et al. because it teaches a way of comparing structural data of molecules relevant to International Application Number PCT/US97/01491 to Patterson et al.

Art Unit: 2863

U.S. Patent No. 6,421,612 to Agrafiotis et al. because it teaches a producing and analyzing a data base of chemical substances.

U.S. Patent No. 6,434,490 to Agrafiotis et al. because it teaches robotically generating a chemical library and determining structure and property information of the generated library members.

U.S. Patent No. 5,577,239 to Moore et al. because it teaches a chemical structure storage, searching, and retrieval system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony T. Dougherty whose telephone number is (703) 305-4020. The examiner can normally be reached on Monday through Friday from 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Barlow can be reached on (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



atd

July 23, 2003



John Barlow  
Supervisory Patent Examiner  
Technology Center 2800